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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

02012.40121

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name _____

Application Number

09/695,175

Filed

October 24, 2000

First Named Inventor

Gomez

Art Unit

2134

Examiner

David Yiuk Jung

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 51,197

Signature

Jennifer L. Overly

Typed or printed name

(202) 835-7512

Telephone number

September 15, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Appl. No. 09/695,175
Pre-Appeal Brief Request for Review

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/695,175
Applicants : Gomez *et al.*
Filed : October 24, 2000
TC/A.U. : 2134
Examiner : David Yiuk Jung

Docket No. : 02012-40121
Customer No. : 38647
For : *Interactive Virtual Library System*

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Commissioner of Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action dated August 3, 2005, Applicants respectfully submit the following Pre-Appeal Brief Request for Review. A Notice of Appeal is filed concurrently herewith.

Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

I. Rejection of claims 1-24 under 35 U.S.C. §103(a).

Claims 1-24 were finally rejected under 35 U.S.C. §103(a) as purportedly obvious over Msdn and Hoyt *et al.* Applicants respectfully traverse this rejection.

The Examiner has not established a *prima facie* case of obviousness for several reasons. First, the Examiner has not provided a reference that qualifies as prior art under 35 U.S.C. §102. Although the Examiner relies on the Msdn reference as invalidating prior art, the reference is dated June 13, 2004 and there is no other evidence that the disclosure the Examiner purports to rely on was public prior to the earliest effective filing date of the above-referenced application. Second, neither Msdn nor Hoyt *et al.* disclose or suggest, either alone or in combination, each and every element of the claimed methods and systems. Specifically, the limitations of dependent claims 3, 6-11 and 19-24 are not met by either the Msdn or the Hoyt *et al.* references. Instead, the Examiner has improperly rejected dependent claims 3, 6-11 and 19-24, as purportedly obvious over knowledge in the art, without providing any references that teach or suggest these elements. Third, there is no motivation to combine or modify Msdn and Hoyt *et al.*

A. The cited reference - Msdn – does not qualify as prior art.

Applicants have traversed the availability of Msdn as a competent reference, because the reference provides no specific teaching of the Msdn system prior to the filing date of this application.

The Examiner has rejected claims 1-24 over Msdn and has provided a document retrieved from the internet on June 13, 2004, which purports to describe the Msdn system. There is no indication, suggestion or means to verify that the Msdn system described in the reference is identical to any Msdn system prior to the filing date of this application. In fact, the reference states that the webpage was last updated in May 2004 – after the filing date of the above-referenced application.

The Examiner has taken the position that “the only way the date can be disputed would to be dispute whether the Microsoft Developer Network disclosed the cited

features before the filing date of the patent application.” *See*, August 3, 2005 Office Action, page 3, paragraph 1. However, there is no indication on the cited reference what features the Microsoft Developer Network had prior to the filing date of this application. The only dates that can be determined from the reference are the May 2004 update date and the June 13, 2004 retrieval date – both of which are after the filing date of this application.

By failing to establish a date of publication of the Msdn reference prior to the filing date of this application, the Examiner has failed to meet his burden of establishing that the Msdn reference qualifies as prior art to this application under any section of 35 U.S.C. §102. Because the Examiner relied on the Msdn reference to reject claims 1 – 24, and because the Examiner has not established that the Msdn reference is prior art, the Examiner has thus failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a).

B. The cited references do not teach each and every limitation of the claims.

The Examiner does not establish a *prima facie* case of obviousness for claims 1-24, because he has not provided a reference to Msdn that predates this application, the Msdn reference and Hoyt *et al.* do not teach each elements of the claimed invention, and there is no motivation to combine these references. *See*, May 18, 2005 After Final Response, page 10, paragraph 4 – page 11, paragraph 3.

The Examiner relies on official notice to establish elements not taught or suggested by Msdn or Hoyt *et al.* Reliance on official notice is permissible under only very limited circumstances. Official notice without documentary evidence to support an examiner’s conclusion should be taken only on the rare occasion when the noticed fact is capable of instant and unquestionable demonstration as being well known. (*See*, MPEP § 2144.03; *see also*, *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970)). That is not the case here. *See*, May 18, 2005 After Final Response, page 12, paragraph 3 – page 13, paragraph 1. Here, the Examiner substitutes official notice for competent references that either teach or suggest the claimed elements.

II. Conclusion

Applicants believe that the above-referenced application is in condition for allowance. Reconsideration and withdrawal of the outstanding rejections and notice of allowance to that effect is respectfully requested.

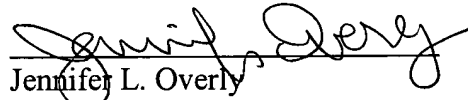
EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 13-3250, reference No. 02012.04121. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

If the Examiner finds that a telephone conference would further prosecution of this application, the Examiner is invited to contact the undersigned at 202-835-7512.

Respectfully submitted,

MILBANK, TWEED, HADLEY & MCCLOY LLP

Dated: September 15, 2005


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